

**REMARKS**

Applicants respectfully request entry of the foregoing and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. § 1.116 and in light of the remarks which follow.

Entry of this Amendment is proper under 37 C.F.R. § 1.116 because the Amendment places the application into condition for allowance (for the reasons discussed herein), or places the application into better form for appeal should an appeal be necessary. The Amendment does not present any additional claims without canceling a corresponding number of finally-rejected claims, it does not raise the issue of new matter, and it does not raise new issues requiring additional search and/or consideration. The amendments were not presented earlier because they are in response to issues raised in the final rejection. Applicants respectfully request entry of the Amendment.

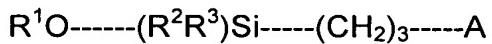
Claims 20-29 are pending in the application.

By the above amendments, Applicants amended Claims 21 and 23 to address the outstanding claim objections. A claim that has been amended in a manner that does not narrow the claim's scope should be accorded its full range of equivalence.

Turning now to the Official Action, Claims 21 and 23 stand objected to for depending on non-elected Claim 1 and Claim 23, respectively. Applicants have amended these claims to obviate the objection. Reconsideration and withdrawal of the claim objection are respectfully requested.

Claims 20-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Urbaniak ("Synthesis of siloxyphosphines"). For at least the reasons that follow, withdrawal of the rejection is in order.

Independent Claim 20 defines a continuous process for preparing an organodialkylalkoxysilane of formula (IX):



comprising the steps of:

a) continuously contacting an alcohol of formula (VIII):  $\text{R}^1\text{-OH}$  in countercurrent with a silane of formula (VII):  $\text{Hal}-(\text{R}^2\text{R}^3)\text{Si}-(\text{CH}_2)_3-\text{A}$ , in order to carry out the alcoholysis reaction of said silane in order to obtain the silane of formula (IX) and a product of formula H-Hal, the operation being carried out with stripping of the product of formula H-Hal formed, and

b) recovering the organodialkylalkoxysilane formed in the reactor, in which formulae the symbol Hal represents a halogen atom selected from chlorine, bromine and iodine atoms, the chlorine atom being preferred; the symbols  $\text{R}^1$ , which are identical or different, each represent a monovalent hydrocarbon group selected from a linear or branched alkyl radical having 1 to 15 carbon atoms and a linear or branched alkoxyalkyl radical having 2 to 8 carbon atoms; the symbols  $\text{R}^2$  and  $\text{R}^3$ , which are identical or different, each represent a monovalent hydrocarbon group selected from a linear or branched alkyl radical having 1 to 6 carbon atoms and a phenyl radical; and

A represents a removable group selected alternatively from: a halogen atom Hal belonging to chlorine, bromine and iodine atoms, or a radical para- $\text{R}^0\text{-C}_6\text{R}_4\text{-SO}_2\text{-O-}$  wherein  $\text{R}^0$  is a linear or branched C1-C4 alkyl radical, or a radical  $\text{R}^0\text{-SO}_2\text{-O-}$

wherein R<sup>0</sup> is as defined above, or a radical R<sup>0</sup>-CO-O- wherein R<sup>0</sup> is as defined above. (Emphasis added.)

Urbaniak relates to disiloxydiphosphines of a specified type synthesized effectively by phosphonation of the corresponding ethoxysimethyl(omega-halogenoalkyl)silanes followed by their hydrolysis (see Urbaniak at abstract).

The Official Action maintains the position that a "continuous process and the use of countercurrent are well-known techniques in a chemical process to optimize the efficiency of the system and does not constitute a patentable distinction. Additionally, merely modifying a process condition such as temperature and concentration is not a patentable modification absent a showing of criticality." Accordingly, the Official Action asserts that the claimed subject matter would have been obvious to one of ordinary skill in the art. (See Official Action at page 2.) Applicants respectfully disagree.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claim features. See *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). In addition, "all words in a claim must be considered in judging the patentability of that claim against the prior art." See *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970), and M.P.E.P. § 2143.03. Applicants submit that these requirements have not been met.

In particular, Applicants again assert that independent Claim 20 includes among the defined combination of features, steps of continuously contacting an alcohol of formula (VIII) in countercurrent with a silane of formula (VII), stripping of the product of formula H-Hal formed, and recovering the organodialkylalkoxysilane

formed in the reactor. Urbaniak does not disclose or fairly suggest a method comprising these steps in combination with the other features of independent Claim 20.

Further, although the Official Action alleges that it would have been obvious to one of ordinary skill in the art to modify the process of Urbaniak in multiple ways, including, for example, (1) making the process of Urbaniak continuous, (2) employing countercurrent, and (3) varying other reaction conditions to arrive at the claimed continuous process, the Patent Office bears the burden of establishing *why* one of ordinary skill would have been led to modify a prior art reference or combine reference teachings to arrive at the claimed subject matter. The requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art, not from Applicants' disclosure (see *Ex parte Nesbit*, 26 U.S.P.Q. 2d 1817, 1819 (B.P.A.I. 1992); and *In re Oetiker*, 24 U.S.P.Q. 2d 1443, 1446 (Fed. Cir. 1992).)

The mere fact that a prior art reference can be modified does not make such a modification obvious without some suggestion that the modification is desirable. (See *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).) There must be some intrinsic basis in the prior art or some extrinsic factor that would prompt one of ordinary skill to modify the teachings of a reference; otherwise the Patent Office's burden of establishing a *prima facie* case of obviousness has not been met. The determination of whether some reason, suggestion or motivation existed for making the combination must be made from the viewpoint of the hypothetical person of ordinary skill in the field of the invention. (See *In re Oetiker*, 24 U.S.P.Q. 2d at 1446 (Fed. Cir. 1992); and *In re Raines*, 28 U.S.P.Q. 2d 1630, 1631 (Fed. Cir. 1993).)

In the present case, no such factor or motivation for modifying the process of Urbaniak exists. Absent any evidence to suggest otherwise, Applicants submit that persons of ordinary skill in the art would simply have no reason to modify the method of Urbaniak in the various ways asserted in the Official Action to arrive at the process of Claim 20.

The Official Action provides no evidence of motivation in Urbaniak or elsewhere that would have led one of ordinary skill in the art to have looked at Urbaniak and modified the disclosed process to obtain the claimed subject matter. Clearly, based on at least the above factors, the motivation for doing so can only come from the teachings of the present specification, which discloses the desirability of the claimed combination of features including the above-specified continuous process steps. However, the teaching, suggestion or motivation for combining or modifying a reference "cannot come from Applicants itself." (See *In re Oetiker*.) The motivation for combining or modifying references cannot be a product of hindsight reconstruction of the claimed subject matter based on Applicants' own disclosure.

Here, the asserted modification of Urbaniak is improper because the reference viewed by itself, and not in retrospect, does not suggest the modification asserted by the Official Action. (See *In re Shaffer*, 228 F.2d 476, 108 U.S.P.Q. 327 (C.C.P.A. 1956); and *In re Stoll*, 523 F.2d 1392, 187 U.S.P.Q. 481 (C.C.P.A. 1975).) Urbaniak does not provide any motivation for modifying the disclosed process and the Official Action provides no other reason that one of ordinary skill would have modified the disclosed process to incorporate each of the features defined in Claim 20.

Further, if the Official Action is asserting official notice to support the rejection, Applicants respectfully oppose the assertion. Applicants do not agree that the claimed combination of process steps is of such "notorious character that official notice can be taken." (See *In re Malcolm*, 129 F.2d 529, 54 U.S.P.Q. 235 (C.C.P.A. 1942).) Thus, if the Official Action is relying on official notice to support the rejection, Applicants traverse the assertion of official notice and request that a reference be cited to support the position taken. (See M.P.E.P. § 2144.03.)

The Official Action also fails to establish that Urbaniak provides a reasonable expectation of success. In particular, M.P.E.P. § 2143.02 states that a reasonable expectation of success is required to establish a *prima facie* case of obviousness. That is, beyond looking to the prior art to determine if it suggests doing what the inventors have done, one must also consider if the art provides the required expectation of succeeding in that endeavor. (See *In re Dow Chem. Co. v. American Cyanamid*, 837 F.2d at 473, 5 U.S.P.Q. 2d at 1531 (both the suggestion and the expectation of success must be founded in the prior art, not in Applicants' disclosure). In this case, however, Urbaniak provides neither a suggestion nor an expectation of success in doing what the inventors have done (i.e., combining the recited steps to arrive at the claimed continuous process for preparing an organodialkylalkoxysilane of formula (IX).) Specifically, the Official Action provides no evidence to indicate that one would have expected to obtain the claimed continuous process by modifying the process of Urbaniak, which is missing several features of Claim 20, to obtain a continuous process for preparing an organodialkylalkoxysilane of formula (IX).

For at least these reasons, Claim 20 is patentable over Urbaniak. The remaining claims (Claims 21-29) depend, directly or indirectly, from Claim 20 and, therefore, are also patentable over Urbaniak for at least the reasons that Claim 1 is patentable. Reconsideration and withdrawal of the §103(a) rejection of Claims 20-29 are respectfully requested.

From the foregoing, Applicants earnestly solicit further and favorable action in the form of a Notice of Allowance.

If there are any questions concerning this paper or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC



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